

## REMARKS

Claims 1-5 have been cancelled, without prejudice.

New claims 6 and 7 particularly point out and distinctly claim subject matter regarded as the invention.

The amendments here presented are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. Support for the amendments herein presented can be found in the specification and claims as filed. No new matter has been introduced as a result of the amendments. Reconsideration and allowance is respectfully requested in view of the amendments and the following remarks.

### The 35 U.S.C. § 102 Rejection

Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Keller (U.S. Patent No. 5,816,575). This rejection is respectfully traversed.

In the Office Action at paper number 11, the Office Action asserts as to claims 1 and 4 that Keller shows providing a side wager that the players first two cards total twenty-one in a form of the Ace/Jack of spades or the Ace/Jack of clubs as shown in FIG. 2. The Office Action asserts that Keller teaches the side wager based upon a paired 10, J, Q, and K. With respect to claims 2 and 5 the Office Action asserts that Keller shows a 21 bet where a player receives an enhanced reward if the dealer's first two cards are a dealer Blackjack. Applicant respectfully disagrees with the assertions in the Office Action.

Claims 1-5 have been canceled, thus the rejection is now moot.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barent, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements "arranged as in the claim."

*Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

The Keller reference fails to disclose each and every claimed element. Specifically, the Keller reference fails to disclose a method of placing a wager on a side bet during a blackjack game comprising placing a wager on a side bet; dealing two cards to a player responsive to said placing said wager; dealing two cards to a dealer responsive to said placing said wager; determining a value of said two cards dealt to said player; determining a value of said two cards dealt to said dealer; awarding a payment to said player responsive to a determination of said value of said two cards dealt to said player equaling twenty and a determination of said value of said two cards dealt to said dealer equaling twenty-one; and issuing said payment according to the following schedule and based on the amount of said wager; same suited queens with dealer twenty-one pays out at least one thousand to one odds, same suited queens pays out at least one hundred twenty-five to one odds, same value cards pays out at least nineteen to one, same suited cards pays out at least nine to one, and any value of twenty pay out at least four to one as claimed in claim 6.

The Keller reference fails to disclose each and every claimed element. Specifically, the Keller reference fails to disclose a product for providing a wager on a side bet during a blackjack game comprising instructions for directing a processor to:

- placing a wager on a side bet;
- dealing two cards to a player responsive to said placing said wager;
- dealing two cards to a dealer responsive to said placing said wager;
- determining a value of said two cards dealt to said player;
- determining a value of said two cards dealt to said dealer;
- awarding a payment to said player responsive to a determination of said value of said two cards dealt to said player equaling twenty and a determination of said value of said two cards dealt to said dealer equaling twenty-one; and
- issuing said payment according to the following schedule and based on the amount of said wager:

same suited queens with dealer twenty-one pays out at least one thousand to one odds;

same suited queens pays out at least one hundred twenty-five to one odds;

same value cards pays out at least nineteen to one;

same suited cards pays out at least nine to one; and

any value of twenty pays out at least four to one; and

a media readable by said processor that stores said instructions, as claimed in claim 7.

Since the prior art reference fails to disclose each and every claimed element, then the prior art reference fails to anticipate the claimed invention. In view of the foregoing, it is respectfully requested that the rejection be withdrawn and it is respectfully asserted that the claims are now in condition for allowance.

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Koelling (U.S. Patent No. 6,158,741). This rejection is respectfully traversed.

Claims 1-5 have been canceled, thus the rejection is now moot.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barent, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

The Koelling reference fails to disclose each and every claimed element. Specifically, the Koelling reference fails to disclose a method of placing a wager on a side bet during a blackjack game comprising placing a wager on a side bet; dealing two

cards to a player responsive to said placing said wager; dealing two cards to a dealer responsive to said placing said wager; determining a value of said two cards dealt to said player; determining a value of said two cards dealt to said dealer; awarding a payment to said player responsive to a determination of said value of said two cards dealt to said player equaling twenty and a determination of said value of said two cards dealt to said dealer equaling twenty-one; and issuing said payment according to the following schedule and based on the amount of said wager; same suited queens with dealer twenty-one pays out at least one thousand to one odds, same suited queens pays out at least one hundred twenty-five to one odds, same value cards pays out at least nineteen to one, same suited cards pays out at least nine to one, and any value of twenty pay out at least four to one as claimed in claim 6.

The Koelling reference fails to disclose each and every claimed element. Specifically, the Koelling reference fails to disclose a product for providing a wager on a side bet during a blackjack game comprising instructions for directing a processor to:

placing a wager on a side bet;

dealing two cards to a player responsive to said placing said wager;

dealing two cards to a dealer responsive to said placing said wager;

determining a value of said two cards dealt to said player;

determining a value of said two cards dealt to said dealer;

awarding a payment to said player responsive to a determination of said value of said two cards dealt to said player equaling twenty and a determination of said value of said two cards dealt to said dealer equaling twenty-one; and

issuing said payment according to the following schedule and based on the amount of said wager:

same suited queens with dealer twenty-one pays out at least one thousand to one odds;

same suited queens pays out at least one hundred twenty-five to one odds;

same value cards pays out at least nineteen to one;

same suited cards pays out at least nine to one; and

any value of twenty pays out at least four to one; and  
a media readable by said processor that stores said instructions, as claimed in  
claim 7.

Since the prior art reference fails to disclose each and every claimed element, then the prior art reference fails to anticipate the claimed invention. In view of the foregoing, it is respectfully requested that the rejection be withdrawn and it is respectfully asserted that the claims are now in condition for allowance.

The 35 U.S.C. § 103 Rejection

Claims 2, 3, and 5 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Koelling (U.S. Patent No. 6,158,741). This rejection is respectfully traversed.

In the Office Action at paper number 11, the Office Action asserts that Koelling shows enhance payouts, which depend upon the cards dealt to the dealer. The Office Action asserts that Koeller requires that a dealer's up card is 10. The Office Action asserts that to have selected a requirement for the dealers up card would have been an obvious matter of choice. Applicant respectfully disagrees with the assertions in the Office Action.

Claims 1-5 have been canceled, thus the rejection is now moot.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q.

494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

The Koelling reference fails to disclose each and every claimed element. Specifically, the Koelling reference fails to disclose a method of placing a wager on a side bet during a blackjack game comprising placing a wager on a side bet; dealing two cards to a player responsive to said placing said wager; dealing two cards to a dealer responsive to said placing said wager; determining a value of said two cards dealt to said player; determining a value of said two cards dealt to said dealer; awarding a payment to said player responsive to a determination of said value of said two cards dealt to said player equaling twenty and a determination of said value of said two cards dealt to said dealer equaling twenty-one; and issuing said payment according to the following schedule and based on the amount of said wager; same suited queens with dealer twenty-one pays out at least one thousand to one odds, same suited queens pays out at least one hundred twenty-five to one odds, same value cards pays out at least nineteen to one, same suited cards pays out at least nine to one, and any value of twenty pay out at least four to one as claimed in claim 6.

The Koelling reference fails to disclose each and every claimed element. Specifically, the Koelling reference fails to disclose a product for providing a wager on a side bet during a blackjack game comprising instructions for directing a processor to:

- placing a wager on a side bet;
- dealing two cards to a player responsive to said placing said wager;
- dealing two cards to a dealer responsive to said placing said wager;
- determining a value of said two cards dealt to said player;
- determining a value of said two cards dealt to said dealer;

awarding a payment to said player responsive to a determination of said value of said two cards dealt to said player equaling twenty and a determination of said value of said two cards dealt to said dealer equaling twenty-one; and

issuing said payment according to the following schedule and based on the amount of said wager:

same suited queens with dealer twenty-one pays out at least one thousand to one odds;

same suited queens pays out at least one hundred twenty-five to one odds;

same value cards pays out at least nineteen to one;

same suited cards pays out at least nine to one; and

any value of twenty pay out at least four to one; and

a media readable by said processor that stores said instructions, as claimed in claim 7.

Since the prior art reference fails to disclose each and every claimed element, then the prior art reference fails to render obvious the claimed invention. In view of the foregoing, it is respectfully requested that the rejection be withdrawn and it is respectfully asserted that the claims are now in condition for allowance.

#### Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited. Entry of this Amendment will place the Application in better condition for allowance. Accordingly, entry of this Amendment is appropriate and is respectfully requested.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,  
SIERRA PATENT GROUP, LTD.

Dated: February 2, 2004



Andrew Gathy  
Reg. No.: 46,441

Sierra Patent Group, Ltd.  
P.O. Box 6149  
Stateline, NV 89449  
(775) 586-9500  
(775) 586-9550 Fax